

## REMARKS

### **Reconsideration And Allowance Are Respectfully Requested.**

5           Claims 1-51 are currently pending. Claims 42, 46, 47, 48 and 51 have been amended.  
No claims have been cancelled. No new claims have been added. No new matter has been  
added. Reconsideration is respectfully requested.

          Support for the amendment regarding the shape of the insert may be found in Figures  
6 and 7. Support for claims regarding the rigidity of the insert may be found at Column 5,  
10 line 47 and, Column 6, line 32, for example.

          Applicant would first like to thank Examiner Passaniti for indicating the allowable  
subject matter found in claims 1-41.

          The Office Action objects to the specification under 37 CFR 1.173 for failing to  
include the entire specification and claims of the patent, with the matter to be omitted by  
15 reissue enclosed in square brackets, and any additions made by the reissue underlined, so that  
the old and new specifications and claims may be readily compared. With this in mind,  
Applicant submits a substitute specification (split copies of the issued patent as suggested by  
the Examiner) in conformance with 37 CFR 1.173. If additional corrections are required, the  
Examiner is urged to contact the undersigned.

20           In addition, the Examiner has objected to the reissue oath/declaration as not stating  
“that all errors which are being corrected in the reissue application up to the time of filing the  
oath/declaration arose without any deceptive intention on the part of applicant.” With this in  
mind, Applicant submits a new declaration as required by the Examiner.

As to the requirement that the original patent, or an affidavit or declaration as to its loss or inaccessibility, be received before the reissue application is allowed, Applicant is currently attempting to locate the original patent and will file the appropriate affidavit or declaration if the original patent is not located.

5           Claims 42-51 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claim subject matter surrendered in the application for the patent upon which the present reissue is based. Specifically, the Office Action suggests “the insert is no longer referred to as a unitary insert, nor is the insert detailed as being at least as rigid as the tubular section, nor is the insert described as being shorter than the tubular section. A review of the original application for the patent shows that the specific term ‘unitary’ and specific phrases  
10           ‘at least as rigid as the tubular section’ and ‘shorter than the tubular section’ were part of the language added to the claims and argued by the applicant to specifically overcome the rejections of the original claims and to place the claims in condition for allowance.”

          Applicant respectfully contends that new independent claims 42 and 47 are  
15           substantially distinct from those prosecuted during the original application for patent. Specifically, claims 42 and 47 attempt to remedy the inventor’s original failure to appreciate the significance of an insert secured at the distal end of the shaft for enhancing swing control, stiffness and flex control, shock absorption and vibration elimination or reduction. As such, the fact that new claims 42 and 47 do not include phrases such as “unitary”, “at least as rigid as  
20           the tubular section” and “shorter than the tubular section” does not reflect Applicant’s

intention to recapture subject matter originally surrendered. Rather, the lack of these terms in the current claims is a result of the focus on subject matter previously not considered during the original prosecution of the present application.

For example, and with reference to claim 42, nowhere in the original prosecution did the inventor attempt to claim a golf club shaft wherein an insert is secured to the second end of a first member, the insert being formed from a vibration absorbing material which absorbs undesirable vibrations resulting from an individual striking a golf ball. Further, and with reference to claim 47, nowhere in the original prosecution does the inventor attempt to pursue patent coverage relating to an insert being formed from a material controlling the stiffness at the distal end of the golf club shaft upon striking a golf ball to thereby stabilize a golf club head secured to the distal end of the golf club shaft. With this in mind, Applicant respectfully requests that the rejection under 35 U.S.C. § 251 be withdrawn.

With regard to the rejections under 35 U.S.C. § 112, Applicant has amended the claims as suggested by the Examiner. These claims are now believed to comply with 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, and Applicant respectfully requests that the rejection thereof be withdrawn.

With regard to the rejections based upon prior art, claims 42 and 47 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,362,048 to Haste (Haste). Claims 44, 45, 49 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Haste. Claims 46 and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Haste in view of U.S. Patent No. 4,555,111. These rejections are respectfully traversed in

view of the preceding amendments and the remarks which follow.

Applicant has amended claims 42 and 47 to substantially define a golf club shaft including a distal end and a butt end. The golf club shaft includes a tubular section having a first end located at the butt end of the golf club shaft and a second end positioned slightly short of the distal end of the golf club shaft. The golf club shaft further includes an insert secured to the second end of the tubular section. The insert extends from the second end of the tubular section to the distal end of the golf club shaft and includes a tubular first end securely coupled to the second end of the tubular member and a tubular second end shaped and dimensioned for secure attachment within a hosel of a golf club head. The insert is formed from a material controlling the stiffness at the distal end of the golf club shaft upon striking the golf ball to thereby stabilize the golf club head secured to the distal end of the golf club shaft. The insert is further formed from a vibration absorbing material which absorbs undesirable vibrations resulting from an individual striking a golf ball.

In contrast to the claimed invention, Haste discloses a resiliently yieldable connector positioned between a golf club head and a shaft. The connector acts as a spring to isolate the reaction of the club head from the shaft when the ball is struck. The Office Action suggests that the fact that the connector is more resiliently yieldable than the head of the shaft results in a connector designed "to absorb vibrations and act as a spring to provide cushioning." While Haste does disclose a connector acting as a spring, Haste does not disclose that the connector functions by absorbing vibrations and it is Applicant's opinion that no

support exists for the Office Action's contention regarding the connector's ability to absorb vibrations. In fact, it is Applicants' opinion that it is highly likely vibrations emanating at the club head will transmit through the spring connector 16 and up through the shaft of the golf club. This is in direct contrast to the golf club shaft claimed in claim 42.

5 In addition to Haste's failure to disclose a vibration absorbing insert, Haste also fails to disclose an insert having a tubular second end shaped and dimensioned for secure attachment within a hosel of a golf club head. In contrast to the claimed second end, Haste discloses a folded connector 16 which is connected to the club head in an undefined manner. However, it is clear that the connector 16 is not secured to the hosel (the disclosed club head has no  
10 hosel) and the second end of the connector 16 does not have a tubular shape permitting attachment within the hosel of a club head.

Further, and with regard to claim 47, Applicant has defined the insert as being a semi-rigid insert. Haste, however, discloses a connector 16 designed to be resiliently yieldable when secured to the shaft of a golf club.

15 In view of the shortcomings of Haste when compared to amended claims 42 and 47, it is Applicant's opinion that claims 42 and 47 overcome the disclosure of Haste and Applicant respectfully requests that the rejection under 35 U.S.C. § 102(e) be withdrawn.

As mentioned above, claims 44, 45, 49 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Haste. These claims generally define specific material  
20 constructions for the claimed insert. For example, claims 44 and 49 defined that the insert is

made from a Lexan or fiberglass composite and claims 45 and 50 define that the insert is made from titanium. In contrast to the claimed invention, Haste discloses a connector 16 preferably formed from spring steel. Despite Haste's failure to disclose a connector 16 manufactured from the materials claimed in claims 44, 45, 49 and 50, the Office Action suggests that it would have been obvious to modify the device disclosed by Haste by fabricating "the yieldable connector (16) from any of a number of convenient materials in order to take advantage of the properties of the material(s)." Applicant respectfully traverses this contention and requests that the Examiner cite prior art supporting this contention if the rejection is maintained in subsequent Office Actions.

Specifically, the claimed materials defined in claims 44, 45, 49 and 50 offer golfers utilizing the claimed invention various striking characteristics neither considered nor suggested by Haste. The claimed materials provide the desired strength, rigidity, control and vibration absorbing characteristics contemplated for optimizing the function of the shaft disclosed and claimed. With this in mind, it is Applicant's opinion that the rejection of claims 44, 45, 49 and 50 under 35 U.S.C. § 103(a) is improper and Applicant respectfully requests that the rejection be withdrawn.

With regard to claims 46 and 51, they define a golf club shaft "wherein the insert includes a central section and a pair of couplers formed on opposite ends of the central section, the central section being approximately 0.5 inch in length." As discussed above, Haste provides no details as to the specific manner in which the connector 16 is secured to the shaft

and/or the club head. However, it is known from the drawings of Haste that the connector 16 is not secured to the club head via a hosel and does not have a tubular shape adapted for attachment to the hosel of a conventional golf club. With this in mind, the Office Action's suggestion that it would have been obvious to utilize the connectors disclosed by Alvarez in modifying the connector 16 disclosed by Haste is improper.

Alvarez is concerned with attaching tubular members by inserting a female member within a male member, while Haste is concerned with somehow attaching a rectangular flap to the uppermost portion of a uniquely formed club head. The construction and attachment mechanisms contemplated by Haste and Alvarez are very different and one looking to modify the connecting mechanism disclosed by Haste would certainly not look to Alvarez.

Further, and with regard to the suggestion that it would have been obvious to modify the connector of Haste to a length of approximately 0.5 inch in length, it is Applicant's opinion that Haste requires a longer connector to provide the resiliently yieldable member contemplated in accordance with disclosed invention. As such, modifying the connector 16 of Haste to increase rigidity would be contrary to the contemplated invention of Haste and Applicant respectfully considers such a modification to be improper. With the foregoing in mind, it is Applicant's opinion that the rejection of claims 46 and 51 under 35 U.S.C. § 103(a) is improper and Applicant respectfully requests that the rejection be withdrawn.

As to claims 43 and 48, the Office Action presents no rejection other than the rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph. Applicant, therefore, asks whether these claims would be allowable if rewritten in independent form or whether these claims are in fact unpatenable for reasons similar to those presented in the outstanding Office Action.

5 For the foregoing reasons, it is Applicant's opinion that claims 1-51 overcome the prior art of record. As such, Applicant respectfully requests that the rejections be withdrawn and the application pass to allowance.

It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested. If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact applicants' representative at the below number.

Respectfully submitted,



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